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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,808	03/11/2002	Shoji Ichinohe	TAKIT 167	9568
23599	7590	04/16/2004	EXAMINER	
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			CHANNAVAJALA, LAKSHMI SARADA	
			ART UNIT	PAPER NUMBER
			1615	

DATE MAILED: 04/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/070,808	Applicant(s) ICHINOHE ET AL.	
	Examiner Lakshmi S Channavajjala	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11-14-03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt of remarks, amendment, declaration and IDS all dated 11-14-03 is acknowledged.

New claim 34 has been added. Claims 1-34 are pending.

Response to Arguments

Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

1. Claim 1 is objected to because of the following informalities: It appears from the instant specification that the molecular weight range of instant claim should read 1000-50,000 instead of 1000-50,00, which is typographical error. For examination purposes, examiner interprets 50,00 as 50,000. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by EP 357037 (EP '037) or JP 54145785 A (JP 785).

Instant claim 1 recites a cosmetic material comprising silicone-modified wax as component A, wherein said silicone-modified wax in which polyethylene and/or polypropylene wax having a molecular weight of 1000-50,00 (see above claim objection) is linked to silicone via an ester linkage.

EP 037 discloses an organopolysiloxane/olefin copolymer that is prepared by reacting an organopolysiloxane with an olefin, where the olefin could be a pentane, hexane, octane etc (page 1). The reaction of the siloxane and olefin is carried out in the presence of a hydrosilylation

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catalyst, and a solvent (page 2). Further, EP 037 discloses that the organosiloxane/alpha-olefin is mixed with a thermoplastic resin, preferably with a polymer of methylene or ethylene (page 2, lines 35-50 and lines 54-55). While EP 037 does not refer to the materials as wax, the organosiloxane/olefin copolymer in combination with the thermoplastic resin reads on the claimed wax. Further, the compound of EP 037 exhibits the same characteristics of a wax material i.e., water repellency, slip and can be extruded into sheets, tubes etc. With respect to the limitation "cosmetic", the preamble limitation does not breath life into the claims and hence carries no patentable distinction. Accordingly, the EP 037 anticipate instant claim 1.

JP 785 discloses a silane modified wax composition useful for adhesives, coating additives, etc., having excellent solvent resistance, adhesive properties, etc., by the graft-copolymerization of a wax with a specific silane compound. 100 parts by weight of a wax having an intrinsic viscosity $[\eta]$ of $0.05 \square 0.8$ (pref. olefin wax) is reacted with preferably 0.5-100 parts by weight of a silane compound having an olefinic unsaturated bond-containing group and a hydrolyzable organic group. JP does not disclose a cosmetic material, however, the preamble recitation does not carry patentable distinction.

3. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 581150 (EP 150).

EP 150 discloses a releasing agent obtained by reacting an organic polysiloxane having a hydroxyl group or an epoxy group with an ethylenically unsaturated dicarboxylic acid grafted

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polyolefin or a reaction product of said grafted polyolefin or a reaction product of grafted olefin and an active hydrogen atom containing compound such as an alcohol, amine or an amino alcohol. In particular, example 1 of EP 150 teaches a reaction of polypropylene with maleic anhydride and the resulting propylene maleate is mixed with hydroxyl containing polysiloxane, thus forming a releaser or binder resin. EP 150 does not use the term wax, however, the resulting resin of EP 150 is the same as that of the instant claims because the process of preparing recited in examples of EP 150 is the same as that described in the instant specification. With respect to the claimed "cosmetic" material, the preamble limitation does not carry patentable distinction. Thus, EP 150 anticipates the instant claims.

Claim Rejections - 35 USC § 103

Claims 1-22 and 27-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 3,641,239 in view of EP 400546 (EP 546).

'239 teach a cosmetic wax composition comprising in a wax base, a coloring agent and an organic wax made of silicone wax. The silicone wax of '239 is a silicone-carnuba wax copolymer in which a silicone moiety is bonded to the wax moiety through a divalent organic radical comprising 2 to 92 carbon atoms (col. 2, lines 3-6). '239 teach that the divalent radical links silicone and wax moieties predominantly by ether but also by ester linkages (col. 7-8, col.9, lines 1-11). '239 teach using the carnuba wax prepared by the above method for preparing lipstick compositions containing other components such as coloring agents, solvents including monohydric or polyhydric alcohols, vegetable oils or waxes that read on the claimed unctuous agents, polysiloxanes, fatty acid esters (which read on the instant surfactants) (col. 16, 17). '239

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teach that the silicone wax can be used in preparing cosmetic compositions such as lipsticks, mascara, solid perfume, chapstick, eyebrow stick etc. '239 fail to teach the claimed polyethylene and/or polypropylene wax and instead teaches carnuba wax.

EP 546 teaches a stable topical composition comprising suspended wax that is prepared by dispersing a synthetic or natural wax (polyethylene or castor wax respectively) with an ester and cyclomethicone resulting in a paste-like material (page 2). EP 546 teaches that the wax used for the suspending wax can be either a natural or a synthetic wax and that the particular identity of the wax is not critical as long as a smooth and creamy sensory feeling is achieved.

Accordingly, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to employ either a natural (castor or carnuba) or a synthetic (polyethylene) wax in the silicone wax composition of '239 and still expect to achieve a cosmetic base that has high wearability, that does not result in phase separation and yet gives a soft and creamy sense to the wearer because EP 546 suggests that the suspended wax comprising n a wax and silicone imparts soft and paste like consistency to the composition and is also free of phase separation (also desired by '239). Further, with respect to the claimed organopolysiloxanes (component H of the instant claims) '239 teaches examples containing dimethyl or diethylsiloxane with different viscosities. Accordingly, choosing a polysiloxane having optimum viscosity in the composition containing suspended wax with an expectation to achieve the desired creamy consistency would have been within the scope of a skilled artisan.

Claims 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 3,641,239 in view of EP 400546 (EP 546) as applied to claims 1-22 and 27-34 above, and further in view of US 5,219,560 to Suzuki.

‘239 teach carnuba-silicone wax compositions comprising polymethyl or polyethylsiloxane that reads on silicone resins of claim 22. However, ‘239 fail to teach acrylic-silicone graft of instant claims.

‘560 teach cosmetic compositions comprising acrylic-silicone graft copolymers having an organosiloxane side chain for use in skin, hair and nail care compositions. The acryl-silicone copolymer of ‘560 is prepared by radical polymerization of a dimethyl polysiloxane having a polymerizable radical group and a radically polymerizable monomer comprising an acrylate or methacrylate or both (col. 2, lines 25-65). The composition of ‘560 further contains low viscosity silicone oil or a cross-linked organopolysiloxane, cosmetic powder, surfactant, volatile solvent etc (col. 2, lines 1-14). The acryl-silicone polymer of ‘560 meets the requirement of acrylic silicone of claims 24-26 (col.3-4). ‘560 teach incorporating the silicone polymer in compositions such as lipsticks, mascara, foundation etc (col. 5, lines 53-66). ‘560 also teach incorporating powders such as silicone (paragraph between col. 11-12), homopolymers of acrylic acid for increasing viscosity (col. 12), surfactants, pigments etc (examples) and also teach preparing the composition in an o/w or w/o emulsions. Examples 16-19 also teach the addition of wax such as carnuba wax, bees wax etc.

Accordingly, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to add the acrylic-silicone graft compounds of ‘560 to the silicone-wax composition of ‘239 with an expectation to increase the water-resistance, water-repellency

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and good retention of make-up (9of '239) when applied because '239 suggests that acryl-silicone grafts copolymers produces a film with sufficient strength such that the make up is resistant to water or oil and is hence retained on the wearer.

RESPONSE TO DECLARATION FILED under 37 CFR 1.132:

Applicants declaration under 37 CFR 1.132 filed 11-14-03 have been considered but not found persuasive because the comparative example presented in the declaration shows that the sample wax (carnuba wax of US 3,641,239) was shown to produce a homogenous mixture whereas the claimed wax is partially insoluble. Based on the results, applicants conclude that the carnuba wax-silicone is useless for the instant invention. However, instant claims do not recite any particular characteristic of the composition nor do they specify if the wax claimed is partially insoluble. Besides, the comparative results are outside the scope of the instant invention because a proper comparison would be an example of the instant composition (such as those described in the instant specification) containing claimed wax versus instant example with carnuba wax.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period


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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 7.30 AM -4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Lakshmi S Channavajjala
Examiner
Art Unit 1615
April 6, 2004

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